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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,444

03/12/2004

Dwight Allen Merriman

11032/3069

5265

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,444

Applicant(s)

MERRIMAN ET AL.

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/17/06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Reply to Office Action filed on November 13, 2007. Claims 1-6 are currently pending and have been considered below.

Information Disclosure Statement

2. The information disclosure statement filed October 17, 2006 has been considered. However, the Examiner notes that due to the enormous number of documents cited on the twenty-eight-page information disclosure statement only a cursory review could be performed. No judgment is hereby made on the pertinency of the cited documents. The Applicant is reminded that such voluminous filings give the appearance that the Applicant is attempting to hide pertinent art. The Applicant is requested to identify the most pertinent prior art and to explain how each reference differs from the claimed invention.

Double Patenting

3. The obvious double patenting rejections in paragraphs 3-6 of the July 12, 2007 Office Action are hereby withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210).

Claim 1: Goldhaber discloses an apparatus for advertising, comprising:

- a. a processor, memory, and database (column 9, line 33 – column 10, line 8);
- b. collecting information based upon a plurality of advertisement requests sent from a user (column 12, lines 14-37);
- c. selecting an advertisement based upon the collected information (column 14, lines 17-40);
- d. basing the advertisement request on a link on a content request from said user (column 7, lines 28-46 and column 16, lines 6-10); and
- e. updating the available advertisements (column 14, lines 23-31).

While Goldhaber does not explicitly disclose generating a report about the placement of advertisements, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide reports about advertisement placement back to the advertisers. One would have been motivated to provide such reports in view of Goldhaber's disclosure that the problem his invention overcomes is

"how will advertisers know that they are getting their money's worth?" (column 5, lines 56-57). Goldhaber further discloses billing the advertiser for the number of "cyber-coins" clicked on by the users. This also implies that the advertiser is receiving a report in order to ascertain both the amount to pay and the basis for the bill.

Claim 2: Goldhaber discloses an apparatus for advertising as in Claim 1 above, and further discloses sending the selected advertisement to the said user for display (column 16, lines 6-10 and column 18, lines 27-33).

Claim 3: Goldhaber discloses an apparatus for advertising as in Claim 2 above, and further discloses receiving a click-through request for information about the advertiser associated with the advertisement (column 11, lines 16-24 and column 16, lines 6-10).

Claim 4: Goldhaber discloses an apparatus for advertising as in Claim 3 above, and further discloses sending a network address (URL) to the user in response to the click-through request (column 16, lines 57-64).

Claim 5: Goldhaber discloses an apparatus for advertising as in Claim 3 above, and further discloses storing information about a prior click-through from said user (column 7, lines 8-19; column 12, lines 14-37; and column 18, lines 1-2).

Claim 6: Goldhaber discloses an apparatus for advertising as in Claim 1 above, and further discloses performing a reverse domain name lookup based upon the advertisement request (column 12, lines 14-37 and column 17, lines 1-3).

Response to Arguments

6. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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JWM
December 26, 2007



James W. Myhre
Primary Patent Examiner